

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

AUG 5 2002

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HIROSHI AKAZUKI
and
NOBUHIDE DOTSUBO

Application No. 09/919,670

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on July 22, 2002. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

An examination of the file reveals that a corrected Information Disclosure Statement (IDS) was filed July 19, 2001 (Paper No. 15). It is not apparent from the record whether the examiner considered the statement submitted or notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

In addition, a review of the record indicates that in the Final Rejection mailed March 26, 2001 (Paper No. 12), claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson and claims 11-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Kare. Appellants reiterated these grounds of rejection on page 9 of their Appeal Brief filed February 6, 2002 (Paper No. 16). In the Examiner's Answer mailed April 23, 2002 (Paper No. 17), however, the examiner lists the following rejections:

1. Claims 1-2, 5, 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al (US5963255) [page 3];

2. Claims 3-4, and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. [page 6]; and

3. Claims 11-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al in view of Kare et al (US5541656) [page 7].

It appears that the §102(e) rejection of claims 1, 2, 5, and 7-10 listed above is a new ground of rejection.

On December 1, 1997, the rule pertaining to the Examiner's Answer and Reply Brief (37 CFR § 1.193) was amended to read as follows:

(a) (2) An examiner's answer must not include a new ground of rejection. . . .

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1. for consideration of the corrected IDS filed July 19, 2001 (Paper No. 15) and appropriate notification to appellants regarding the Examiner's decision;

2. for a determination regarding the status of the rejection of claims 1, 2, 5, and 7-10 under 35 U.S.C. § 102(e). If this rejection is to remain, the rejection is considered to be a new ground of rejection and the entry of the Examiner's Answer mailed April 23, 2002 (Paper No. 17) is inappropriate. Accordingly, the Examiner's Answer needs to be vacated and

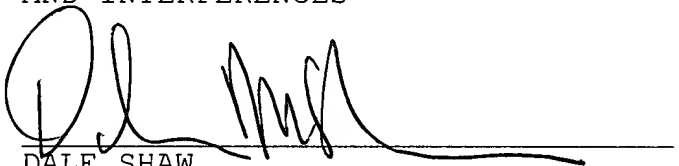
Application 08/919,670

prosecution reopened. If the rejection is to be withdrawn, the Examiner's Answer will need to be vacated and a Supplemental Examiner's Action issued in its place.

3. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:


DALE SHAW
Program and Resource Administrator
(703) 308-9797

cc: Michaelson & Wallace
Parkway 109 Office Center
328 Newman Springs Road
P.O. Box 8489
Red Bank, NJ 07701

ds\psb\lrc
RA020115